

## REMARKS

Applicants thank Examiner Kim for his indication of the allowability of claims 38-67 in the pending Office Action. The examiner also reviewed and made final his restriction requirement. Although it is still believed that as a practical matter the consideration of claims 32-37 would not be significantly additionally burdensome, in the interest of moving this case along, those claims have been cancelled without prejudice to their future consideration in this or a continuing application.

The pending Office Action also issued initial rejections of claims 1-31. First, claim 1 was initially rejected as allegedly indefinite in its use of the word "rod." On review of claim 1, it is apparent that "rod" was a typographical error, and the term "shaft" was intended in its place. The specification describes, among other things, a sleeve member slidable along a shaft member. No narrowing of the claim is intended or should be inferred.

Additionally, the Office Action alleged that claims 1-31 are either anticipated by or obvious over the single Beale reference (U.S. Patent No. 6,440,133). However, it is respectfully noted that the Beale reference does not, in fact, show at least one recited element of each of claims 1-31, and therefore the rejections should be withdrawn, and the claims allowed.

With respect to independent claim 1, the Office Action supposes that the recited base, shaft, plate and sleeve are found in particular parts of the Beale reference. In particular, the Office Action suggests that the recited plate is item 80 in Beale, its aperture is item 98a, and the recited shaft is items 100 and 120 in the reference. Applicant does not concede or necessarily agree with the Office Action's characterization of the claim language or the Beale reference. However, even if those characterizations are assumed correct, for the sake of argument, Beale does not show its alleged "plate" being pivotably connected to its alleged "shaft," as claim 1

recites. A brief review of the figures in the Beale reference shows that item 80 is not pivotably connected to items 100 and 120. Comparing Figs. 1 and 2 of Beale, it appears that item 100 of Beale slides along item 80 toward the end portion 88 of item 80, and that item 100 cannot perform any pivoting with respect to item 80 due to the structural interrelationship of the two parts.

Further, the Beale reference does not show a plate in a position for locking to an implant or in a position for accepting insertion of a part of an implant, as claim 1 recites. Item 80 of Beale, which is supposed to be a “plate,” does not lock to or accept insertion of an implant. Neither items R or Y of figures 1-3 of the Beale reference appear to be locked into or inserted into item 80 of that reference. Thus, even assuming the Office Action’s comparison of certain parts of the Beale reference to language of claim 1 is apt, the reference does not show all elements of that claim arranged as specified in the claim.

Claims 2-14 were initially rejected as allegedly obvious over the Beale reference by itself. Each of these claims is allowable because of its dependence on allowable claim 1. As noted above, the characterizations in the Office Action of the Beale reference’s disclosure and the pending claim language in this case is not conceded or necessarily agreed with.

With respect to claim 2, the Office Action asserts that a “ratchet mechanism” attached to a handle in Beale could be connected to a base and sleeve as recited in claim 2. The only basis given for that conclusion was that “rearranging parts of an invention involves only routine skill in the art.” Respectfully, the rejection of claim 2 is insufficient on at least two grounds. First, no motivation to make such a change was given in the Office Action, and no such motivation is apparent in the Beale reference. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the

desirability of the combination.” MPEP 2143.01 (emphasis in original, and citation omitted). Further, “A statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art’ . . . because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason” to combine or modify the references. MPEP 2143.01 (emphasis in original, internal quotations and citation omitted). Because there is no evidence of an objective motivation to modify Beale, or of any desirability of such modification, no proper *prima facie* case of obviousness has been presented.

Second, what the Office Action proposes with this rejection is somehow connecting items including toothed bar 70 and lever 74 of Beale to its items 58, 59, 130 and 140 (alleged to constitute a “base”) and to item 88 (alleged to be a “shaft”). It is not evident from the Beale reference how that connection could be accomplished. Moreover, connecting a ratchet mechanism to item 88 of Beale places it very close to bone (see Figs. 1-3 of Beale) and most likely below the level of the skin and other adjacent tissue. Such placement would give a substantial risk of interference to the use of the ratchet mechanism by fluids or tissues, and a surgeon would have to reach down into the surgical site in order to operate and/or release the ratchet mechanism. Thus, not only is there no motivation or desirability for the proposed modification of the Beale reference, but the change also fundamentally alters the operation of the reference and makes it less desirable. Since no *prima facie* case of obviousness of claim 2 exists, it is allowable on its own merit.

Claims 3-8 are allowable due to their dependence from allowable claims 1 and 2. They are also likely allowable on their own merit insofar as the Office Action’s characterization of the Beale structure is incorrect or affected by hindsight.

Claims 9 and 11 are also allowable due to their dependence from one or more allowable claims, and on their own merit. The Office Action provides the same reasoning to assert that “finger” 66b of Beale can be moved to items 58, 59, 130 and 140 (alleged to constitute a “base”) as was provided in its consideration of claim 2. Accordingly, for the same reasons noted above, there is no prima facie case of obviousness of claims 9 and 11, or claims 10 and 12-14 dependent from them. Further, the Office Action is unclear in its rejection of claims 9 and 11, since it claims in its analysis of claim 2 that “finger” 66b is a part of a ratchet mechanism, but then with respect to claim 9 it calls “finger” 66b a “stop” that is “connected to the ratchet mechanism.” The Office Action treats item 66b of Beale as part of a ratchet mechanism in one place, and as connected to the mechanism in another. Respectfully, it is submitted that that inconsistency indicates that the subject matter of claims 2 and 9 are not shown or suggested by the Beale reference.

As to claim 10, it is clear from Beale that its “finger” 66b is integral with “arm” 54. See Beale, column 9, lines 32-36. Arms 52 and 54 of Beale are biased away from each other by springs, and thus “finger” 66b and toothed bar 70 are biased away from each other. It cannot be said that Beale shows its items 66b and 70 biased toward a position in which they are connected. For at least this reason, as well as its dependence from allowable claims, claim 10 is allowable.

Claims 12-14 are allowable due to their dependence from allowable claims and on their own merit. For example, claim 13 recites three pawls independently operable, and claim 14 recites that the pawls are nested. The only basis given for that conclusion was that “mere duplication of the essential working parts of a device involves only routine skill in the art.” As discussed above, without a proper objective motivation to modify a reference and a showing of the desirability of the modification, the assertion of “routine skill in the art” is not sufficient to

show obviousness. Here, there is no suggestion in Beale of any reason to use more than one “finger” 66b in its structure, and placing another such integral “finger” on arm 54 would not provide finer adjustability or any other advantage. In short, multiple rigid “fingers” as shown in Beale appear to work just as a single rigid “finger.” Furthermore, any additional “fingers” according to Beale would be integral with arm 54, and if one were engaged with toothed bar 70, they all would be engaged with toothed bar 70 as a function of how the Beale reference operates. They would not be able to operate independently of each other, as claim 13 recites. Nesting such hypothetical additional “fingers” would hide one or more of such “fingers” in or around another, thereby impeding any function they may have. Adding “fingers” as the Office Action suggests, would not be considered desirable because they would perform no function beyond “finger” 66b, and would thus add cost without advantage. Since there is no evidence of an objective motivation to modify Beale as the Office Action suggests with respect to claims 13 and 14, or of any desirability of such modification, no proper prima facie case of obviousness has been presented.

Claims 15-23 were alleged to have been anticipated by the Beale reference. These claims are allowable because of their dependence on allowable claim 1, and also on their own merit. For example, the Office Action alleges that item 98a of Beale is the aperture recited in claims 15 and 18, and that it is “partially or uniformly tapered.” However, an examination of Figs. 6 and 8 of Beale shows that conclusion to be incorrect. The perspective view of Fig. 6 appears to show a flat surface surrounding hole 98a, and the top view of Fig. 8 does not appear to show any variation in the diameter of hole 98a. Thus, the figures do not support the conclusion that there is a tapered portion of hole 98a. Even if the aperture of the claims can properly be compared to hole 98a of Beale, the reference does not show the recited taper. As to claim 17, the Office

Action suggests that item 96 of Beale is a “roughened surface adjacent said aperture.”

Respectfully, it is noted that item 96 of Beale is at the other end of item 80 from hole 98a, and “branch” 96 does not appear to be roughened or have roughened parts. As to claim 20, the Office Action suggests that item 91a of Beale is a “rounded surface,” but it does not explain how item 91a “facilitates pivoting of said plate.” As already noted, item 80 does not pivot, and so it is not sound to suggest that anything facilitates its pivoting. In addition to these bases, as already stated, the Office Action’s characterizations of the Beale reference’s disclosure and the claim language is not conceded or necessarily agreed with, and thus there are likely other grounds for the allowability of claims 15-23 as well as those noted above.

Claims 24-26 were initially rejected as obvious over the single Beale reference. No prima facie case of obviousness has been made, for the reasons already discussed with respect to claim 2. Further, moving the spring from one place to another in Beale would fundamentally change the operation of the reference. Essentially, the Office Action proposes taking spring 72 from between handles 52 and 54 and placing it against item 100. Doing so would eliminate the outward biasing between handles 52 and 54 on which the Beale device relies for proper operation, and would appear to bias item 100 toward the bone. The Beale device operates by having item 100 relatively near the handles 52 and 54 in an “at-rest” mode, and squeezing the handles moves item 100 slowly toward the bone. It is not evident from the Office Action or from Beale itself against or with respect to what part of the Beale device the rearranged spring 72 would act. Of course, if the Office Action means to suggest that Beale can be modified by adding another spring to abut item 100, that scenario suffers from the same defects previously noted. If it could be done, it would be redundant to spring 72, adding cost without advantage. In sum, no proper motivation or evidence of desirability of the proposed modification has been

supplied, and the proposed modification with change the mode of operation of the Beale reference.

Similarly, there is no motivation to change the leaf spring of Beale to concentric springs as recited in claim 26. Such concentric springs, if connected to item 100 of Beale, would have to occupy the same space as item 80 in Beale. Thus, either item 80 would have to be substantially changed or eliminated, or the concentric springs and item 80 would interfere with each other. In either case, there is no basis evident from the Beale reference to fulfill the motivation and desirability requirements of a prima facie case of obviousness.

As to claims 27-31, which were alleged to be anticipated by Beale, they depend from allowable claim 1 and, as already discussed, the Office Action's characterizations of the Beale reference's disclosure and the claim language is not conceded or necessarily agreed with. In addition, the Office Action asserts that "pins" 139 and 149 (see Beale column 9, lines 7-17) are a "closure" and a "latch" as recited in claims 28 and 29. The Office Action implicitly suggests that "opening" pins 139 and 149 allows the separation recited in claim 28 and the pivoting recited in claim 30. It is not seen how one or two pins could be or include a latch, what the definition of "opening" them could be, or how such "opening" could both allow separation and pivoting. Respectfully, the ambiguity and inconsistency of the Office Action's analysis point toward a conclusion that there is no case of anticipation of claims 27-31 over Beale.

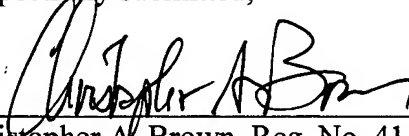
It should be understood that the above amendments and remarks are not intended to provide an exhaustive basis for patentability or concede the basis for the rejections in the Office Action, but are simply provided to address the rejections made in the Office Action in the most expedient fashion. Applicants reserve the right to later contest positions taken in the Office

Action that are not specifically addressed herein.

In responding to this Office Action, Applicants do not intend to limit the scope of pending or later-offered claims. The claims in this application are intended to have their full scope, including equivalents, to which their language entitles them.

In conclusion, Applicants thank Examiner Kim for allowing claims 38-67. Claims 32-37 have been cancelled without prejudice, and as noted above, claims 1-31 are allowable over the cited Beale reference. Accordingly, a Notice of Allowance in this case is respectfully requested.

Respectfully submitted,



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